

## **REMARKS**

### **I. Claims in the Case**

Claim 20 has been amended. Claims 43, 49, 51, and 87-89 have been canceled. Claims 43, 49, 51 were abandoned based on the belief that the claims were potentially confusing and redundant to other claims. Claims 3, 4, 20, 21, 23-29, 36-42, 44-48, 50, 52-76, and 85-86 are pending.

Many of the claim amendments reflect comments from discussing the case with the Examiner. With respect to claim 24, the Examiner questioned "what length". This has been clarified. With respect to claim 29, the Examiner observed that ligase chain reaction would not be appropriate for an extension involving the use of a primer. With respect to claim 38, the Examiner queried what it meant, and the meaning has now been clarified. Claims 43, 49 and 51 were said to be confusing. Applicants agree and have chosen to simply cancel these claims as generally repetitive and redundant to other existing claims.

### **II. Response to Notice of Non-Compliant Amendment**

In the Notice of Non-Compliant Amendment dated 4/20/06, the Examiner takes the position that the previous amendment "does not address the issue related to priority." The Examiner was contacted and he advised that there was no statement appearing at the first sentence of the specification that made reference to the parent application, now US patent 6,221,600.

Applicants disagree. Enclosed is a copy of the original "Request for Filing Continuation Application Under 37 C.F.R. §1.53(b)" filed with the present continuation application on April 23, 2001. As can be noted from paragraph 11 of that document, the office was instructed to amend the specification before the first line with the following sentence:

“—This is a continuation of co-pending application Serial No. 09/414,847 filed October 8, 1999 now issued as U.S. Patent No. 6,221,600—“

### **III. Objection to Claim 20**

Applicants have amended claims 20 to address the objection regarding “said first” and “said second” primer.

### **IV. Rejections Under 35 U.S.C. §112, First Paragraph**

The Action next rejects all of the pending claims under 35 U.S.C. §112, first paragraph, taking the position that various phrases used in the claims are not adequately described in the specification.

In response, Applicants would first note that the rejection is more properly one under 35 U.S.C. §112, second paragraph, but will respond nonetheless in order to progress the case towards allowance.

The Action first complains of the phrase “a predetermined 5’ sequence”, “a predetermined linker” and “wherein each member of the pair anneals to a different predetermined linker sequence.” These phrases are found in claims 87-89.

This rejection is now moot in light of the cancellation of these claims.

The Action also complains of the use of the term “random” in claim 20. Claim 20 has now been amended to clarify that two separate primer populations are employed, wherein the primer set populations have specificity regions that comprise random sequence combinations of A, T, G and C. Support for the amendments to claim 20 can be found at the top of page 21. As explained in the first two paragraphs of page 21, an aspect of the invention involves the use of a

specificity region incorporating such a random sequence to provide a specificity region that will anneal to the target.

**V. Rejection of Claims 87-89 as Anticipated by Senapathy '058**

The Action next rejects claims 87-89 as anticipated by the Senapathy '058 patent. As each of these claims are now canceled, this rejection is moot.

**VI. Rejection of Claims 87-89 as Anticipated by Silver**

The Action next rejects claims 87-89 as anticipated by Silver.

Again, as these claims are now canceled, the rejection is believed to be moot.

**VII. Rejection of Claims 87-89 as Anticipated by Senapathy '428**

The Action next rejects claims 87-89 as anticipated by Senapathy '428, taking the position that Senapathy '428 teaches separate primer sets that meet all the limitations of the rejected claims, referring in particular to claim 25.

Again, as these claims are now cancelled the rejection is believed to be moot.

**VIII. Rejection of Claims as Obvious Over Senapathy '428 in View of Isaacs *et al.***

The Action lastly rejects the remaining claims as obvious over the combination of Senapathy '428 in view of Isaacs *et al.*

In response, Applicants have amended the presently rejected claims in a manner that the Examiner has previously indicated would distinguish over the combination of Senapathy '428 and Issaacs et al., by directing the first step of the base claim 20 to "preparing a DNA molecule by attaching a first linker sequence at one end of the DNA molecule and attaching a second linker sequence, different from said first linker sequence, at the other end of the DNA molecule." This is believed to distinguish over the references in that neither reference teaches the concept of

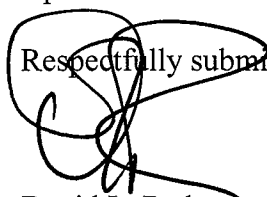
preparing such a DNA molecule and then fashioning primers that anneal to and prime off of such prepared DNA molecules.

## **IX. Conclusion**

It is believed that in light of the foregoing the present case is in condition for allowance and favorable action thereon is earnestly solicited. If the Examiner has any questions, comments or recommendations, he is earnestly requested to contact the undersigned representative.

Please date stamp and return the enclosed postcard to evidence receipt of this document.

Respectfully submitted,

A handwritten signature in black ink, appearing to be "D. Parker", written over the words "Respectfully submitted,".

David L. Parker  
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Date: June 20, 2006



PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Dkt. No.: UTSC:607USC1

Prior Application Examiner:  
SIU, S.

BOX PATENT APPLICATION  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Classification Designation:  
435-006.000

Prior Group Art Unit: 1631

CERTIFICATE OF EXPRESS MAILING

NUMBER: EL548523447US  
DATE OF DEPOSIT: April 23, 2001

REQUEST FOR FILING CONTINUATION APPLICATION  
UNDER 37 C.F.R. § 1.53(b)

This is a request for filing a continuation application under Rule 53(b) (37 C.F.R. § 1.53(b)) of co-pending prior application Serial No. 09/414,847 filed October 8, 1999, entitled "COMBINATORIAL OLIGONUCLEOTIDE PCR: A METHOD FOR RAPID, GLOBAL EXPRESSION ANALYSIS."

- ☒ 1. Enclosed is a copy of the prior application Serial No. 09/414,847 as originally filed, including specification, claims, drawings, and declaration. The undersigned hereby verifies that the attached papers are a true copy of the prior application as originally filed and identified above, that no amendments (if any) referred to in the declaration filed to complete the prior application introduced new matter therein, and further that this statement was made with the knowledge that willful

false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statement may jeopardize the validity of the application or any patent issuing thereon.

(a) ☒ The inventorship is the same as prior Application Serial No. 09/414,847.

(b) ☐ Deletion of inventor(s). Signed statement attached deleting inventor(s) named in the prior application, see 37 C.F.R. § 1.63(d)(2) and 1.33(b).

(c) ☐ Priority of foreign patent application number , filed in is claimed under 35 U.S.C. § 119(a)-(e). The certified copy:

☐ is enclosed.

☐ has been filed in the prior Application Serial No.

☒ 2. The Commissioner is requested to grant Applicants a filing date in accordance with Rule 1.53, and supply Applicants with a Notice of Missing Parts in due course, in accordance with the provisions of Rule 1.53(f).

☐ 3. Enclosed is a check in the amount of \$ to cover the filing fee as calculated below and the fee for any new claims added in the Preliminary Amendment referred to in Part No. 9 below.

CLAIMS AS FILED IN THE PRIOR APPLICATION  
LESS CLAIMS CANCELED BELOW

FOR	NUMBER FILED	NUMBER EXTRA	RATE	FEE
Basic Fee -----				\$355.00
Total Claims	84 - 20 =	64 X	\$9.00 =	\$576.00
Independent Claims	1 - 3 =	0 X	\$40.00 =	\$0.00
Multiple Dependent Claim(s) -----				\$-0-.00
<b>TOTAL FILING FEES:</b>				<b>\$931.00</b>

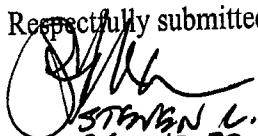
- ☒ 4. Applicant is entitled to Small Entity Status for this application.
- ☐ (a) A small entity statement is enclosed.
- ☒ (b) A small entity statement was filed in the prior nonprovisional application and such status is still proper and desired.
- ☐ (c) Small entity status is no longer claimed.
- ☒ 5. If the check is missing or insufficient, the Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 to 1.21 which may be required for any reason relating to this application, or credit any overpayment to Fulbright & Jaworski, L.L.P. Deposit Account No. 50-1212/10017175/01982.
- ☐ 6. Enclosed is a copy of the current Power of Attorney in the prior application.
- ☒ 7. Address all future communications to:
- David L. Parker  
FULBRIGHT & JAWORSKI, L.L.P.  
600 Congress Avenue, Suite 2400  
Austin, Texas 78701  
(512) 474-5201
- ☒ 8. The prior application is presently assigned to Board of Regents, The University of Texas System.

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- ☐ 9. Enclosed is a preliminary amendment. Any additional fees incurred by this amendment are included in the check at No. 3 above and said fee has been calculated after calculation of claims and after amendment of claims by the preliminary amendment.
- ☐ 10. Cancel in this application claims of the prior application before calculating the filing fee. (At least one original independent claim must be retained).
- ☒ 11. Amend the specification by inserting before the first line the sentence: --This is a continuation of co-pending application Serial No. 09/414,847 filed October 8, 1999 now issued as U.S. Patent No. 6,221,600--.
- ☒ 12. Enclosed are formal drawings.
- ☐ 13. An Information Disclosure Statement (IDS) is enclosed.
- ☐ (a) PTO-1449.
- ☐ (b) Copies of IDS citations.
- ☒ 14. Transfer the sequence information, including the computer readable form previously submitted in the parent application, Serial No. 09/414,847 filed October 8, 1999, for use in this application. **Under 37 C.F.R. § 1.821(e), Applicant states that the paper copy of the sequence listing in this application is identical to the computer readable copy in parent application Serial No. 09/414,847 filed October 8, 1999. Under 37 C.F.R. § 1.821(f), Applicants also state that the information recorded in computer readable form is identical to the written sequence listing.**
- ☒ 15. Other: Request for Transfer of Sequence Listing Under 37 CFR 1.821(e).



- ☒ 16. Return Receipt Postcard (should be specifically itemized).

Respectfully submitted,

  
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Date: April 23, 2001

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